

### **REMARKS/ARGUMENTS**

Claims 87, 129, 177, 179, and 182 are amended; claim 191 is new; and claims 87-88, 91, 95-99, 101, 102, 112, 114, 128-131, and 175-191 are pending and subject to examination, upon entry of this amendment. No new matter has been added. Support for the amendment can be found, for example, in paragraphs [0022], [0047], and [0065] of the originally filed specification.

#### **35 U.S.C. §112, Second Paragraph**

Claims 184-185 are rejected as being indefinite. At page 3 of the Office Action, the Examiner alleges that “it is unclear about the meaning of the phrase 'substantially off-line manner'.” The rejection is traversed.

The originally filed specification provides meaning to the noted phrase in paragraphs [0022] and [0065]. From paragraph [0065]: “..(4) where the information relative to the receipt is generated at the point of sale or service in a substantially off-line manner, that is, where the base device does not generally have to retrieve information from a different remote system to complete the receipt creation;..” (emphasis added). Thus, it is quite clear that the meaning of the noted phrase is both supported and explained by the specification, as one commonly skilled in the art would recognize. Accordingly, withdrawal of the §112 rejection is requested.

#### **35 U.S.C. §102**

Claims 87-88, 91, 95-99, 101-102, 112, 114, 128-131, and 175-183 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,590,038 to Pitroda et al. "Pitroda". The rejection is traversed.

#### **Independent claims 87 and 177**

Pitroda fails to anticipate independent claims 87 and 177, and any claims dependent thereon, as each and every element of the claims is not taught or suggested by the Pitroda. Independent claim 87 recites, *inter alia*, “a base device communicatively coupled to a portable device, the base device associated with an identifier, the base device storing a plurality of electronic receipt policies.” Independent claim 177 recites a similar limitation.

The claims were previously amended to specify that the “base device” is a “point of sale device.” In the current Office Action, the Examiner stated on page 4:

"a base device (See Pitroda: Fig 2: Item 23 (POS) in conjunction with item 26 (main central computer))".

Thus, the Examiner is combining the CIU 21, POS 23, and the main central computer 26, as recited in Pitroda, to anticipate the "base device" of the instant claims. It is well known that “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil of California*, 814 F.2d 628, 631; 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Thus, for anticipation the “identical invention must be shown in as complete detail as is contained in the ... claim”. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236; 9 USPQ2d 1913, 1920 (Fed. Circ. 1989). MPEP §2131. Accordingly, this is an improper anticipation rejection, as the Examiner is combining at least three different elements from Pitroda to anticipate a single element of the instant claims.

As noted previously, there is simply no suggestion in Pitroda to use a “plurality of receipt policies” in a POS device. If Pitroda’s main computer has “receipt policies,” then Pitroda teaches away from having a “plurality of receipt policies” in a POS device. If one were to modify Pitroda to arrive at the present claims, the main central computer 26 would cease to become a main and central part of Pitroda’s system.

Further, in response to the Applicant's argument, the Examiner stated on page 20:

"POS has all details necessary to generate an acceptable receipt (A receipt is one of the steps of an overall transaction) to all parties involved. Thus it has to have the required policies for its use." (emphasis added).

The Examiner further stated on page 20:

"Thus, POS is not a pass through between the main central computer 26 and a UET card 20. It has the capability to complete the transaction (including the receipt) with all necessary details and requirements." (emphasis added).

Thus, as there is no direct support in Pitroda to anticipate the instant claims, the Examiner is now arguing that the POS as recited by Pitroda inherently includes the instant claim limitations. These arguments are improper because they are based on mere possibilities derived from Applicant's own disclosure.

"The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). MPEP §2112.

Pitroda does not inherently recite a POS which stores a plurality of different receipt policies. The Examiner's own interpretation provides other possibilities as recited on page 20:

"It should also be noted that Pitroda's system can deal with different service providers and it operates in an off-line manner to complete the transaction (except authorization)."

Accordingly, under the Examiner's interpretation, it is possible that explicit receipt information for a specific transaction can be provided during authorization from a service provider, removing any need for the system of Pitroda to include a plurality of receipt policies. Thus, as other possibilities are present, as one commonly skilled in the art would recognize, inherency has not been properly established.

Additionally, Pitroda does not teach or suggest, *inter alia*, "wherein the point of sale device generates the electronic receipt in a substantially offline manner such that it does not have to retrieve receipt relative information from a remote system to generate the electronic receipt using the transaction dependent select policy of the plurality of electronic receipt policies", as required by amended claim 87, which was made solely to expedite prosecution of the instant application. Independent claim 177 recites a similar limitation. As interpreted by the Examiner, for Pitroda to recite use of "a plurality of receipt policies", Pitroda allegedly requires a POS to be "in conjunction with" with a separate main central computer to generate a receipt from receipt policies stored on the main central computer. Thus, as the main central computer 26 is remotely located from the POS 23 and separated by a telephone line (Pitroda, Fig. 2), Pitroda does not recite the newly added claim limitation.

In light of the above, Accordingly, Pitroda does not anticipate claims 87 and 177, and all claims dependent therefrom.

### **Independent claim 129**

Claim 129 is re-written into independent form and the amendment thereof does not raise a new issue requiring further search and/or consideration. With respect to claim 129, Pitroda does not teach or suggest, *inter alia*, "wherein the electronic receipt includes a validity period." The Examiner referenced on page 8, as anticipatory of the above claim limitation, the following:

"..transaction to the point of sales computer, the UET card, and the American Express service. Those details include the date of the transaction, the amount, the name of the retail store or service (for the UET card and the American Express service records), the name of the customer (for the American Express and point of sales computers), etc." (Pitroda, Col. 17, lines 1-5.

There is absolutely no mention of a "validity period" in the quote above, and the Examiner has not relied official notice to support the rejection. Further, on page 15 of the Office Action with reference to claim 187, the Examiner admits: "Pitroda does not explicitly give validity period as one of the receipt feature." Accordingly, the rejection is improper.

### **Independent claim 182**

Pitroda does not teach or suggest, *inter alia*, "identifying an electronic receipt of a plurality of electronic receipts on a portable device using an identifier associated with a base device used in an associated transaction, wherein the base device is a point of sale device.", (emphasis added). Applicants specifically requested that the Examiner directly cite and explain where "POS identification is one of the basic details of any receipt when generated" is found in Pitroda, however, this was not performed. Accordingly, Applicant's prior argument and request still stands.

Pitroda also does not teach or suggest, *inter alia*, "retrieving the electronic receipt using the base device from the portable device after verifying the electronic receipt; and

conducting a transaction with the point of sale device using the retrieved electronic receipt", as amended herein solely to expedite prosecution of the instant application. Pitroda does not recite any use of a retrieved receipt from a portable device for conducting a transaction.

In light of the above, Pitroda does not anticipate claim 182, and all claims dependent therefrom.

### **Independent claim 179**

Claim 179 is re-written into independent form and the amendment thereof does not raise a new issue requiring further search and/or consideration. With respect to claim 129, Pitroda does not teach or suggest, *inter alia*, "wherein receipt management comprises deletion, by a base device, of an electronic receipt stored on the portable device if the electronic receipt is invalid or confirmed for deletion". The Examiner referenced on pages 10-11, as anticipatory of the above claim limitation, the following:

"..transaction to the point of sales computer, the UET card, and the American Express service. Those details include the date of the transaction, the amount, the name of the retail store or service (for the UET card and the American Express service records), the name of the customer (for the American Express and point of sales computers), etc." (Pitroda, Col. 17, lines 1-5.

There is absolutely no mention of "deletion, by a base device, of an electronic receipt stored on the portable device if the electronic receipt is invalid or confirmed for deletion", nor deletion of any kind, in the quote above, and the Examiner has not relied official notice to support the rejection. Accordingly, the rejection is improper.

### **35 U.S.C. §103**

Claims 187 and 186 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pitroda in view of Marshall et al. (US 2003/0055733 A1). Claim 189 is rejected under 35

U.S.C. 103(a) as being unpatentable over Pitroda in view of Himmel et al. (US 6,898,598 A1). Claims 188 and 190 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pitroda in view of Smith et al. (US 6,487,540 81). The rejections are traversed.

The rejected claims derive patentability from independent claims 87 and 177, and also recite novel and non-obvious claim limitations which are not taught or suggested by the prior art. Accordingly, the rejected claims are not obvious in view of the noted references.

**CONCLUSION**

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 415-576-0200.

Respectfully submitted,

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